



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/090,299

03/04/2002

Basil Naji

131279 - 1144

6646

7590

02/06/2007

Robert J. Ward  
Gardere Wynne Sewell LLP  
1601 Elm Street, Suite 3000  
Dallas, TX 75201

EXAMINER

MARCANTONI, PAUL D

ART UNIT

PAPER NUMBER

1755

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

31 DAYS

02/06/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

8

<b>Office Action Summary</b>	<b>Application No.</b> 10/090,299	<b>Applicant(s)</b> NAJI ET AL.	
	<b>Examiner</b> Paul Marcantoni	<b>Art Unit</b> 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-20 are is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 15-20 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

The applicants' 1/12/07 RCE and response is noted. Applicants' remarks will be held in abeyance and commented upon after applicants elect a species below:

This application contains claims directed to the following patentably distinct species: *fly ash*, *alumina trihydrate*, *silica flour*, *cenospheres*. The species are independent or distinct because they are mutually exclusive (see new claims 15-20).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (note: applicants cannot elect a combination or mixture because they have no support for doing that from their original disclosure) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 15 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

Art Unit: 1755

The following comments below are also noted for applicants so that they may correct in their next response regarding coming rejections under 35 USC 112 (new matter) and 35 USC 112 second paragraph (indefinite) and fully resolve:

New Matter:

Claims 3,15,16,18,19, and 20 <sup>would</sup>~~would~~ be rejectable under 35 USC 112 first paragraph and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed.

The term "microspheres" in claim 3 is new matter. There is only support for ceramic hollow microspheres, not any or all microspheres of different material or solid microspheres. See [0039].

The terms "and the like" is new matter in claim 3 (and indefinite).

The terms "*more than 25% water* and up to 50% water" is new matter. While there is support for "up to 50% water" (see [0021]), there is no support for ---more than 25% water---. Further, it is unclear what units of % are being used. Are applicants using weight percent (wt%) or volume percent (vol%).

The terms "wherein the dewatering aid permits dewatering of the slurry in a few minutes" is new matter in claim 18. This is because dewatering to a few minutes is only supported for "fly ash" and no other dewatering aid. The specification does not say other dewatering aids such as alumina trihydrate, silica flour, cenospheres also dewater in a few minutes. Only support is given for fly ash from original disclosure.

The limitation " wherein the particulate material includes a particle size greater than 100 microns" is new matter in claim 19". There is only support for this coarse

Art Unit: 1755

fraction being limited to bottom ash or similar products from coal combustion (see [0038]). It is new matter because alumina trihydrate and silica flour cannot represent a similar product from coal combustion. It is possible fly ash and fly ash cenospheres are similar products (not of same exact composition) only in that they are products of combustion and that's all. Is that what applicants mean by "similar products", not compositionally identical but combustion products containing the same components? It appears bottom ash, fly ash, and fly ash cenospheres do contain similar components though not in an identical composition. Clarification of the terms "similar products" as listed in their specification is respectfully requested.

The terms "products of coal combustion" would appear to be new matter in claim 20. There is only support for similar products of coal combustion but it is unclear what applicants mean by "similar products" of coal combustion. This term is also thus indefinite from their original disclosure.

35 USC 112 Second Paragraph:

Claims 3, 15, and 16 would be rejectable under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The terms "and the like" in claim 3 are indefinite.

Claim 15 is indefinite as applicants do not provide whether the percentage water is weight percent or volume percent.

Claim 16 is indefinite (and also fails to further limit independent claim 15) because the percentage of about 25-60 wt% silica, about 10-30 wt% alumina, about 5-

Art Unit: 1755

25 wt% iron oxide, about 0-20 wt% CaO, and about 0-5 wt% MgO only applies to fly ash. As this is the composition for fly ash, it is not the composition for alumina trihydrate in claim 16, silica flour, or even fly ash cenospheres (their composition is not exactly the same as fly ash though it has mostly the same components).

Finally, applicants are respectfully requested to elect a single species for new claims 15-20 and correct any problems pointed out by the examiner that are new matter or indefinite under 35 USC 112 first paragraph, 35 USC 132, and 35 USC second paragraph.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni  
Primary Examiner  
Art Unit 1755